



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT
APPLICATION OF: Eugene J. Rollins, *et al.*
SERIAL NO.: 09/747,651
FILING DATE: December 22, 2000
ATTORNEY DOCKET
No.: 031792-0311567
CONFIRMATION NO.: 9835
ART UNIT : 3677
EXAMINER MICHAEL J. KYLE
FOR: PRE-FILLING ORDER FORMS FOR TRANSACTIONS OVER A COMMUNICATIONS
NETWORK

REPLY BRIEF

Mail Stop Appeal Brief-Patents

Commissioner for Patents
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Sir:

I. INTRODUCTION

This Reply Brief is being filed within two months of the Examiner's Answer mailed November 1, 2005. This Brief responds to the points raised by the Examiner's Answer.

The Status of the Claims

Claims 1-2, 4, 6, 8-10, 12-16, 18, 20, 22-24 and 26-29 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Markus (U.S. patent No. 6,499,042) hereinafter referred to as "Markus '042".

Claims 3 and 17 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Markus '042 in view of Markus et al. (U.S. Patent No. 6,490,601), hereinafter referred to as "Markus '601".

Claims 5, 11, 19 and 25 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Markus '042 in view of Godin et al. (U.S. Patent No. 5,890,138), hereinafter referred to as "Godin".

Claims 7 and 21 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Markus '042 in view of Rhoads (U.S. Patent No. 6,285,776).

Claims 7 and 21 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

II. RESPONSE TO EXAMINER'S ARGUMENTS

A. Claims 7 and 21 Particularly Point Out and Distinctly Claim the Subject Matter as Required Under 35 U.S.C. §112, second paragraph.

The Examiner's rejection of claims 7 and 21 as allegedly failing to particularly point out and distinctly claim the subject matter as required under §112 second paragraph by claiming a "tracer image," is woefully fraught with legal errors. "Tracer image" language has been in the application since its original filing. The Examiner did not reject the "tracer image" language under §112 in the First Office Action of October 3, 2003 nor in the Final Office Action of April 6, 2004. Apparently only after realizing that the art rejection of these claims is wholly without merit did the Examiner throw in a 112 rejection. Yet, inconsistently, the Examiner contends that, prior to the invention, tracer

images were known from the disclosure of Rhoads. See Final Office Action of May 2, 2005 at pg.7 ¶1-2 and Examiner's Answer at pg. 15 lines 3-8. Moreover, despite the Appellant spoon feeding the Examiner numerous citations to where tracer images are disclosed, in detail, in the specification, including what they are and how they are used in the context of the invention, the Examiner selectively ignores many of the citations. The Examiner alleges that the disclosure at pages 26-28 does not enable one to identify what a tracer image actually is. See Examiner's Answer at pg. 15 lines 19-20. An extensive discussion of tracer images also appears at pages 5-6.

The specification as a whole must be considered. 35 U.S.C. §112, second paragraph requires that (1) the claims set forth the subject matter that applicants regard as their invention; and (2) the claims particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. The term "tracer image" in claims 7 and 21 fully satisfies the requirements of 112 second paragraph. The term "tracer image" as used in claims 7 and 21 is clearly set forth in the Appellants' Specification.

In the Appeal Brief, Appellants cite sample passages from the Appellants' Specification which explain the meaning and usage of "tracer image." See Appeal Brief at pg. 13 ¶1. For simplicity, portions of the Appellants' Specification are set forth below:

Another solution to this problem involves the use of what are known as "tracer images." This generally involves merchants providing to all interested shopping applications data that uniquely identifies particular transactions and then relying upon shopping applications to claim origination of certain transactions. FIG. 2 is a block diagram 200 that illustrates example web pages and a conventional approach for using tracer images to track transactions. See Appellants' Specification at pg. 5 lines 15-20.

Order confirmation page 206 includes a tracer image 208 that identifies attributes of the completed transaction. Tracer images may be implemented in several ways. For example, tracer images may be represented by a single dot or pixel so that customers do not notice them. They are embedded on the Hyper-Text Markup Language (HTML) order confirmation page on a merchant site as an image (IMG) tag, where the source (SRC) attribute of the image consists of the URL of an order confirmation tracking server hosted by the shopping application. This tracking URL also includes attributes about the transaction that was just completed by the customer. Example attributes include, without limitation, a merchant identification number, an order identification number, a total amount of merchandise purchased or currency denomination. See Appellants' Specification at pg. 6 lines 4-13.

The cookies are used to specify attributes of transactions, such as the identity of the customer, the identity or address of the merchant, the product chosen by the customer, the product's price, the date and time of the transaction, or any other data associated with the transaction.

In addition, the merchant includes a tracer image on the merchant's order confirmation page for each completed transaction. As described previously, the tracking URL for the tracer image may include data that specifies various attributes of transactions, such as the identity of the customer, the product or service chosen by the customer, the product's price, the date and time of the transaction, or any other data associated with the transaction. Significantly, the tracking URL for the tracer image need not contain, or include, any information about the origination address for the transaction, such as the URL of a shopping application at which the customer may have begun the transaction. See Appellants' Specification at pg. 26 lines 7-18.

The Examiner's Answer admits that Appellants' Specification describes how a tracer image can be used, but alleges that the cited passages "do not *enable* one of ordinary skill in the art to identify what a tracer image actually is, rather than how it works in different applications." See Examiner's Answer at pg. 15 lines 19-21. From this, it appears that the Examiner is confusing the requirements under 112, second paragraph with the *enablement requirement* under 112, first paragraph.

The “tracer image” is fully disclosed (and enabled) by the Appellants’ Specification. Therefore, the rejection under 35 U.S.C. §112, second paragraph, is improper and should be withdrawn.

B. Claims 1, 2, 4, 6, 8-10, 12-16, 18, 20, 22-24, and 26-31 are Patentable over Markus ‘042.

1. Markus Fails to Disclose all Elements of Independent claims 1, 15, and 29

The Examiner continues to erroneously allege that Markus ‘042 anticipates each and every recitation of at least independent claims 1, 15, and 29. *See* Examiner’s Answer at pg. 4 line 4+. The Examiner’s position is legally improper for at least the reason that the Examiner’s reliance on Step 20 of Markus ‘042 is misplaced.

Claim 1 recites, among other things: “*receiving, by an intermediary disposed between the client and the server, a request from the client for an electronic document located at a first address at the server, the request made by a user at the client....providing the updated electronic document to the client for the user in response to the request.*” Claims 15 and 29 recite similar features.

As demonstrated by the illustration below, the Examiner considers the claimed client, intermediary, and server, to be *analogous* to the document browser 13, selective proxy 14, and document server 15, respectively, in Markus ‘042. *See* Examiner’s Answer at pg. 8 ¶4. Even with this interpretation, the Examiner commits legal errors by: i) ignoring the specific recitations, including the recitations regarding what each of the components do ii) selectively ignoring portions of the Markus ‘042 disclosure; and failing to consider each claim as a whole.

As claimed, the request for an electronic document is made by the client and *received by the intermediary*. In contrast, in Markus, the request is made by the Document Browser (allegedly analogous to the Client) but *received by the Document Server* (allegedly analogous to the Server). However, the Examiner selectively ignores the clear disclosure in Markus, which states:

The first step, denoted as 16 in the diagram [Fig. 3 of Markus '042], occurs when an external entity instructs its Document Browser to fetch a document containing form elements. The Document Browser then contacts the Document Server module in 17 and formally requests the desired document. See Markus '042 at col. 3 lines 21-25.

Ignoring this clear disclosure in Markus that the document request from the user is received by the Document Server (Step 16 in Markus), the Examiner instead attempts to rely on Steps 20/24 of Markus. These steps however relate to a second *separate request* 20 from the client for auto-fill and occur after the first request 16 is made and the document has been sent from the Document Server to the client¹. See Markus '042 col. 3 lines 21-25 as cited above and col. 3 lines 26-30 and 33-36, below:

After the Document Server returns the requested document in 18, the external entity activates a form autofill trigger located in the recently loaded document as shown in 19. The autofill trigger causes the Document Browser to contact the Selective Proxy as depicted by the line marked 20. See Markus '042 at col. 3 lines 26-30.

Once the entity enters its login information and has the Document Browser send it back to the Selective Proxy as indicated in 22 and 23 the normal autofilling process may continue. See Markus '042 at col. 3 lines 33-36 (*emphasis added*).

At a high level the difference in the data flows can be illustrated as follows.

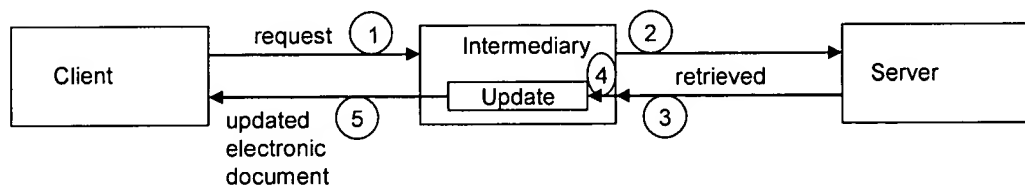
¹ The Examiner erroneously alleges that request 20 “initiates the process.” Answer at p. 9. Clearly, this is not accurate. The process starts at Step 16 as clearly shown in Fig. 3 and as described in Markus '042 at col. 3 lines 21-25.

According to this interpretation, the Examiner alleges that the selective proxy 14, or intermediary, receives a request from the client for an electronic document and the document is located at a first address on the server. See Examiner's Answer at pg. 8 ¶4.

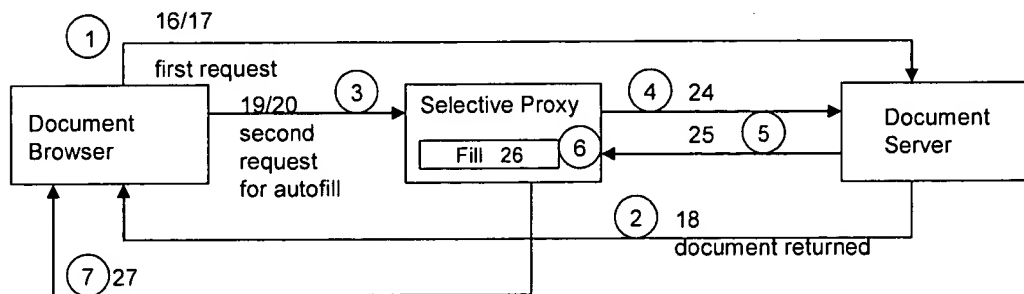
Examiners Alleged Correspondence

Claims	Client	Intermediary	Server
Markus '042	Document Browser (13)	Electronic Proxy (14)	Document Server (15)

Invention-Electronic Document Request/Updating



Markus-Electronic Document Request/Updating



The Examiner has failed to show that Markus discloses all the elements of at least claims 1, 15, and 29 for at least the following reasons.

- i. Markus '042 does not disclose "receiving, by an intermediary...a request from the client for an electronic document..."

Markus '042 fails to disclose "receiving, *by an intermediary*...a request from the client for an electronic document located at the first address at the server..." Rather, Markus '042 clearly discloses that the document server 15 (server), not the selective proxy, receives a request from the document browser 13 (client) for the desired document, as illustrated in the figure above. See Markus '042 at col. 3 lines 21-25.

As such, Markus '042 fails to disclose the intermediary (selective proxy 14) receiving "a request from the client for an electronic document."

The Examiner erroneously states that the intermediary receives a request from the client for an electronic document at step 20. See Examiner's Answer at pg. 9 lines 4-13. The Examiner's reliance on Step 20 in Markus '042 is legally flawed because Step 20 relates to an autofill request. The autofill request is not an initial request *for an electronic document* as claimed, because at this point, the electronic document already has been requested (Step 16) and retrieved (Step 17). See Markus '042 at col. 3 lines 21-36.

As such, the Examiner's reliance on Step 20 is legally erroneous because it fails to disclose the document request step as claimed.

- ii. Markus '042 fails to disclose a client request for an electronic document and providing an updated electronic document in response to *the* request.

Another legal error is that the Examiner selectively ignores the claims as a whole. In claim 1, for example, the client makes a single request for the document (which is

passed to the intermediary), the intermediary retrieves the documents and user information and auto-fills the document (the “updated document”), and returns the updated document to the client in response to “*the request*.” Thus, claim 1 makes clear that there is only a single request made by the client to retrieve and auto-fill the document. In stark contrast, Markus ‘042 requires two separate requests and involves different steps. In steps 16/17 of Markus ‘042, the client makes a first request and the Document Server implements that request and returns to the client the requested document. Then in a second, separate request (Step 20) the autofill is performed and the updated document is returned to the client in response to this second request, not the first.

Thus, according to the claim elements, the client requests an “electronic document” and receives an “updated electronic document” in response to the request. However, in Markus ‘042 the client may request an electronic document and receive an electronic document (see Markus ‘042 at col. 3 lines 21-25), then has to perform a subsequent action from the already received electronic document to trigger the filling out of the document in order to receive an “updated electronic document.” See Markus ‘042 at col. 3 lines 25-45.

The Examiner further argues that the autofill request serves as a request for the document located at a first address on the document server 15 because the intermediary requests that a document be retrieved. See Examiner’s Answer at pg. 9 lines 19-20. However, claims 1, 15, and 29, recite, among other things, the claim feature of: “a request from the client for an electronic document...*the request made by a user at the client*.” As such, Markus ‘042 relates to a request by the selective proxy 14, *not* the document browser 13, for the document.

Accordingly, the rejection of claims 1, 15, and 29 is improper and must be overturned because the reference fails to teach or suggest all of the features of the claimed invention.

2. Dependent claim 2, 4, 6, 12, 18, 20, 23, 26, 30, and 31

The arguments from the Examiner's Answer (see pg. 9-10) fail to establish that Markus '042 discloses each and every feature of the claims 1, 15 and 29, as detailed above. As such, at least the dependent claims 2, 4, 6, 12, 18, 20, 23, 26, 30, and 31 are allowable because they depend from allowable independent claims 1 and 15, as well as for the further limitations they contain. Furthermore, the comments presented in the Appeal Brief are relied upon here for separate patentability of the claims. Therefore, the rejection of claims 2, 4, 6, 12, 18, 20, 23, 26, 30, and 31 is improper and should be reversed.

3. Markus '042 fails to disclose the features of dependent claims 8 and 22 including "retrieving, via a post from a server, information associated with the user."

The Examiner's reliance on Step 26 of Markus '042 is legally erroneous. Dependent Claims 8 and 22 recite, among other things, "retrieving, via a post from a server, information associated with the user." The Examiner's Answer erroneously alleges that step 26 of Markus '042 shows the posting of information associated with a user and that this information is retrieved as a result of the post from a server. See Examiners Answer at pg. 10 ¶2.

Step 26 (see Markus '042 at FIG. 3) does not disclose a post from a server. Rather, Step 26 shows that the selective proxy 14 processes the document (in the context

of the current external entity) and that all the empty form fields in the document are filled out by the proxy 14. See Markus '042 at col. 3 lines 38-42 and Fig. 3. This does not involve “*retrieving, via a post from a server, information associated with the user*” because the selective proxy 14 processes the document using information stored at the selective proxy.

Markus '042 states:

The Selective Proxy records the transaction for future reference in 30. By recording the transaction, the Selective Proxy is able to learn about the external entity so that future autofills will be more complete and accurate. See Markus '042 at col. 3 lines 48-51.

In fact, the Examiner even acknowledges that the information associated with the user comes from previously saved information at the selective proxy. See Examiners Answer at pg. 10 line 13.

Thus, the Examiner has failed to show that Markus '042 discloses at least the claim features of “*retrieving, via a post from a server, information associated with the user*” as recited in claims 8 and 22. As such, at least the dependent claims 8 and 22 are allowable for these reasons and because they depend from allowable independent claims 1 and 15, as well as for the further limitations they contain. Furthermore, the comments presented in the Appeal Brief are relied upon here for separate patentability of the claims. Therefore, the rejections on claims 8 and 22 are legally improper and should be reversed.

4. Dependent claims 10 and 24

The rejection of these claims is legally insufficient because Claims 10 and 24 depend from claims 1 and 15, respectively. Claims 10 and 24 recite, among other things, the claim feature of, “*retrieving information associated with the user from a wallet*

server.” Assuming *arguendo* that the features in Markus ‘042 cited by the Examiner (see Examiner’s Answer at pg. 10, ¶3) do teach the element(s) of claims 10 and 24, the rejection of claims 10 and 24 are still improper for at least the stated deficiencies of Markus ‘042 presented above with regard to independent claims 1 and 15. As such, the rejection of claim 10 and 24 are improper and should be reversed.

5. Markus ‘042 fails to disclose the claim elements of dependent claims 13 and 27.

Claims 13 and 27 depend from claim 1 and 15, respectively. Claims 13 and 27 recite, among other things, “*determining whether one or more variables included in the electronic document include valid user data; and...revising the electronic document by substituting one or more data values from the information associated with the user for the one or more variables.*” The Examiner alleges these features are disclosed in Markus ‘042 because Markus ‘042 fills the blanks fields with user data. The Examiner based this on the flawed premise that a blank field in the form is not valid user data. This rejection is legally incorrect for at least the following reasons.

i. A blank field is not necessarily invalid data.

The Examiner concludes, without any factual support, that a blank field is invalid data. This is not necessarily the case. It is well known that in many cases, forms may include optional information fields. In at least those cases, blank fields may be valid.

ii. Markus ‘042 does not make a determination of whether included variables are invalid.

The Examiner does not even allege, if a field value is not blank, that Markus ‘042 checks that included value to see if it is valid. Clearly, there is no express disclosure in

Markus '042 of an affirmative step of “determining whether one or more variables included in the document include valid user data...”

- iii. Examiner’s reliance on the filling of “blank fields” does not meet the claim language of “revising...by substituting.”

The claim expressly recites determining if included variables are valid. Markus '042 merely looks for where no variables are included (i.e. blank fields). It is beyond cavil that a blank field is the absence of a variable in a particular field. The claim expressly refers to variables that in fact are *included* in the document. For similar reasons, Markus '042 fails to disclose “revising the electronic document by *substituting* one or more data values from the information associated with the user for the one or more variables” (*emphasis added*). Substitution of variables implies changing one value for another. Supplying a missing variable is not a substitution but rather an initial input of the variable.

Appellants’ Specification distinguishes between *substituting* an input variable with valid user information and making an initial inclusion of variables where no value yet exists. For example, Appellants’ Specification states:

According to one embodiment of the invention, order form pre-filling is performed generally by identifying variables, inputs, or other data fields on the order form. Those variables, inputs, or data fields that require information about the user on the order form are identified and then *portions of the user information for the appropriate variables are substituted into the form*. In practice, variables sometimes are not established with initial values as in the above example. Order forms may nevertheless be modified to include or modify the value of variables based upon user information, e.g., user information retrieved from a wallet server as discussed in the examples above.
See Appellants’, Spec. at pg. 39 lines 8-pg. 40 line 2 (emphasis added).

Markus '042 simply discloses filling out an *empty* field. As such, Markus '042 fails to disclose *revising by substituting* one or more data values for the one or more variables, as claimed.

Thus, Markus '042 does not disclose the claim features of claims 13 and 27. As such, at least the dependent claims 13 and 27 are allowable because they depend from allowable independent claims 1 and 15, as well as for the further limitations they contain. Furthermore, the comments presented in the Appeal Brief are relied upon here for separate patentability of the claims. Therefore, the rejections of claims 13 and 27 are improper and should be reversed.

6. Markus '042 does not disclose the features of claims 14 and 28 including, examining a context in which variables are used in an electronic document.

Claims 14 and 28 depend from claim 1 and 15, respectively. Claims 14 and 28 recite, among other things, “examining a context in which each of the one or more variables is *used in the electronic document*; identifying a particular data value from the plurality of data values, wherein the particular data value conforms to the context in which each of the one or more variables is used.”

The Examiner alleges that Markus '042 states that “all the empty form fields in the document are filled with relevant information” (see Markus '042 at col. 3 lines 39-41) and that for relevant information to be placed in the correct field, the context of the empty fields *must* be examined. See Examiner’s Answer at pg. 12 lines 5-7. The Examiner, however, fails to offers any support within Markus '042 for alleging that the context of the empty fields *must* be examined, much less support for the claim feature of

“examining a context in which each of the one or more variables is used *in* the electronic document. In fact, to the contrary Markus ‘042 discloses:

When the requested document arrives in 25, it is processed *in the context of the current external entity* and all the empty form fields in the document are filled in with relevant information as task 26 shows. See Markus ‘042 at col. 3 lines 38-42.

As such, Markus ‘042 discloses processing in the context of the current external entity (e.g. user), not the “context in which each of the one or more variables is used in the electronic document”, as claimed. Markus ‘042 refers to the general context of a user, not the context of the variables in the document. For example, Appellants’ Specification discloses that the context for a variable is examined with respect to the document itself including other portions of the form as they appear to the user. See excerpts of Appellants’ Specification below.

There may be situations in which the mapping is unable to match a variable on an order form to a portion of the user information. One approach might be to leave that variable unchanged. However, an alternative embodiment is to look at the context associated with the variable on the order page as it appears to the user. For example, the variable name for the ship first name on a particular merchant's web page might just be "name1" from which it would be unclear whether that was referring to the first or last name. However, the variable on the form may have a more descriptive label that aids the user in providing the proper information. For example, referring to FIG. 9, "ship first name" 918 displays a description of the information to be entered into input field 920 that is used to specify the value of "name1" which makes clear that the proper input for "name1" is the first name. See Appellants’ Specification at pg. 40 lines 15-24.

Therefore, in the current invention, particular data values may be identified to conform to the context in which each of the one or more variables is used within a document. Markus ‘042, does not disclose this. As such, at least the dependent claims 14 and 28 are allowable because they depend from allowable independent claims 1 and 15,

as well as for the further limitations they contain. Furthermore, the comments presented in the Appeal Brief are relied upon here for separate patentability of the claims. Therefore, the rejections on claims 14 and 28 are improper and should be reversed.

B. Claims 3 and 17 are Patentable over Markus '042 in view of Markus '601.

1. Dependent claims 3 and 17

Claims 3 and 17 depend from claim 1 and 15, respectively. Claims 3 and 17 recite, among other things, “storing the information associated with the user such that the information may be used with one or more other electronic documents.” Assuming arguendo that the features in Markus '601 cited by the Examiner (see Examiner’s Answer at pg. 7, ¶1) do teach the element(s) of claims 3 and 17, the rejection of claims 3 and 17 are still improper because the combination of Markus '042 and Markus '601 fails to teach the deficiencies of Markus '042, as set forth above. Markus '601 fails to disclose at least the claim element of “receiving, by an intermediary disposed between the client and the server, a request from the client for and electronic document located at a first address at the server.” As such, the rejection of claims 3 and 17 is improper and should be reversed.

C. Claims 5, 11, 19, and 25 are Patentable over Markus '042 in view of Godin.

1. Godin is Non-Analogous Art

As stated in the Appellants’ Appeal Brief, the rejection is improper because Godin is non-analogous art. The Examiner appears not to contend that Godin relates to the same field of endeavor as the invention. The Examiner alleges, without factual

support, that Godin is reasonably pertinent to the particular problem with which the Appellant was concerned. See Examiner's Answer at pg. 13 line 7.

Some of the problems with which Appellants were concerned include securely processing orders including the inability for customers to return easily to a shopping application after having been transferred from the application or a merchant web site; the completion of order forms; and the payment of commissions to shopping applications and portals. See Appellants' Specification at pg. 7 line 20- pg. 8 line 5. Godin addresses none of these problems. Moreover, there is no evidence that a person of ordinary skill in the art would reasonably have been expected to solve the problems addressed in the present invention by considering the problems addressed in Godin.

Rather, the Examiner relies on a selected passage within Godin that has the keyword "encrypted." This is legally insufficient as it does not show Godin addresses the same problems as the invention. In Godin, encrypted data is ancillary to the main issue. Godin is directed to the problem of auctioning products online. See Godin, col. 1 lines 58-60 and Abstract cited below:

The present invention is directed to a method of auctioning products on-line where participants use computer terminals to access a computer site and participate. See Godin at col. 1 lines 58-60.

An auction system is disclosed which allows users to participate using their own computers suitably connected to the auction system. Preferably, this connection uses INTERNET. The invention involves a method and system for providing rapid feedback of a reverse auction process and removes the user from the process once an indication to purchase has been received. Rapid feedback in combination with security of information is achieved with the method and auction system. See Godin at Abstract.

The Examiner has failed to provide any evidence to overcome the fact that Godin is concerned with neither the field of the invention's endeavor nor the problems addressed in the present invention.

2. Neither Markus '042 nor Godin Disclose the claim features of, "retrieving information associated with the user from an encrypted wallet cookie."

Claims 11 and 25 recite, among other things, the claim feature of "retrieving information associated with the user from an encrypted wallet cookie." The Examiner's Answer admits that Markus '042 does not disclose an *encrypted* wallet cookie, as claimed, but alleges that Godin stores encrypted personal information that is "similar" to information found in wallet cookies. See Examiner's Answer at pg. 14 lines 7-11. This is legally insufficient. Neither Markus '042 nor Godin disclose an encrypted wallet cookie, as claimed.

3. No Suggestion to Combine Markus '042 and Godin.

Moreover, the combination of Markus '042 and Godin is improper. The Examiner alleges a motivation to combine by alleging that "personal information *can be* encrypted to prevent unauthorized use and access to the information ...thus, based on the teachings of Godin, one of ordinary skill in the art would be motivated to encrypt the wallet cookie of Markus '042 for increased security and data protection." See Examiner's Answer at pg. 14 lines 13-16. Even if this could be done, this does not constitute a proper legal suggestion to combine the references, absent a suggestion in the references to do so.

The general allegation that encrypted data increases security does not adequately reflect why it would have been obvious to modify the form filling system of Markus '042

with the auctioning system of Godin. The rejection is classic case of hindsight with no evidentiary support for a suggestion to combine.

As such, at least the dependent claims 5, 11, 19, and 25 are allowable for at least the forgoing reasons and because they depend from allowable independent claims 1 and 15, as well as for the further limitations they contain. Furthermore, the comments presented in the Appeal Brief are relied upon here for separate patentability of the claims. Therefore, the rejections on claims 5, 11, 19, and 25 are improper and should be reversed.

D. Claims 7 and 21 are Patentable over Markus '042 in view of Rhoads.

The Section 103 rejection based on Markus '042 and Rhoads is improper because Rhoads is non-analogous art and there is no motivation to combine the two references. Claims 7 and 21 recite, among other things, the claim feature of “receiving, via a tracer image, information associated with the user.” The Examiner states the Rhoades is cited *solely* for teaching a tracer image. See Examiner’s Answer at pg. 15 line 8.

1. Rhoads is Non-Analogous Art.

The Examiner erroneously alleges that Rhoads is pertinent to the problem with which the Appellant is concerned. See Examiner’s Answer at pg. 14 line 21 – pg. 15 line 2. There is no evidence that a person of ordinary skill in the art would reasonably have been expected to solve the problems addressed in the present invention (see Appellants’ Specification at pg. 7 line 20- pg. 8 line 5) by considering the problems addressed in Rhoads. The Examiner’s Answer fails to even cite any part of Rhoads in order to provide alleged evidence of such. Rather, the Examiner merely refers to the keyword “tracer”

included within Rhodes. See Examiner's Answer at pg. 15 lines 3-4. This is legally insufficient.

Rhoads is not concerned with any of the stated problems addressed by the invention. Rhoads is clearly directed to the problem of identifying equipment used in counterfeiting. See Rhoads at col. 1 lines 34-37.

The present invention relates to embedding binary data in image data so as to identify, e.g., equipment with which the image data was processed. The invention finds particular application in deterring counterfeiting of banknotes. See Rhoads at Abstract.

In contrast, the invention uses tracer images in part, to determine payment of commissions in an e-commerce environment. From this, it is clear that Rhoads is not concerned with particular problems of the present invention, nor does the Examiner show that Rhoads relates to the same field of endeavor. As such, the Examiner has failed to provide evidence to show that Rhoads is analogous art. Thus, Rhoads cannot be legally considered in the Section 103 rejection.

2. There is No Suggestion to Combine Markus '042 and Rhoads.

Assuming Rhoads could be considered, the Examiner fails to preset proper motivation to combine Markus '042 and Rhoads. The Examiner alleges that one having ordinary skill in the art would look to the teaching of Rhoads for the transfer of data using a tracer image, to directly provide user information. See Examiner's Answer at pg. 15 lines 13-15. The Examiner fails to preset proper motivation to combine Markus '042 and Rhoads. Rhoads is directed to identifying equipment used in counterfeiting banknotes. There is no mention of filling in order forms online. The general allegation that a tracer image *may be used* with Markus '042 is not legally sufficient. There is no

suggestion in the references that it would have been obvious to modify the form filling system of Markus '042 with the counterfeit identifying system of Rhoads. The rejection simply provides no evidentiary support for a suggestion to combine.


As such, at least the dependent claims 7 and 21 are allowable for at least the forgoing reasons and because they depend from allowable independent claims 1 and 15, as well as for the further limitations they contain. Furthermore, the comments presented in the Appeal Brief are relied upon here for separate patentability of the claims. Therefore, the rejections on claims 7 and 21 are improper and should be reversed.

Appellants now appeal to this Honorable Board to promptly reverse these rejections and issued a decision in favor of Appellants. All of the claims are in condition for allowance.

Date: **January 3, 2005**

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